

REMARKS/ARGUMENTS

The Office Action notes that claims 1-3, 34-39, 41, 42, and 44-67 are pending in the application. By this amendment, claim 1 has been amended and Applicant notes that the Examiner has withdrawn claim 57-67 from consideration. The amendment to claim 1 is fully supported by the Specification and does not add any new matter to the application. Therefore, claims 1-3, 34-39, 41, 42, and 44-56 are currently pending in the application.

In the Office Action, the Examiner: (1) rejected claims 1-3, 44, and 56 under 35 USC §102(b); and (2) rejected claims 34-39, 41, 42, and 45-55 under 35 USC §103(a). Applicant responds to the Examiner's objections and rejections below.

Claim Rejections - 35 USC §102

The Examiner rejected claims 1-3, 44, and 56 under 35 USC §102(b) as being anticipated by Cousins. Applicant respectfully submits that claims 1-3, 44, and 56 are not anticipated by Cousins.

As to claim 1, as amended, Cousins does not disclose a motor mounting platform "wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least one motor support" as recited in claim 1, as amended. In Cousins, the brushes 50, which are current carrying components, are in contact with the motor mounting platform 38 through springs 56, 58, which are electrically conductive components. Therefore, Applicant respectfully submits that claim 1 is not anticipated by Cousins.

Claims 2-3, 44, and 56 are dependent on claim 1, therefore, for the above reason are also not anticipated by Cousins.

Claim Rejections - 35 USC §103

The Examiner rejected claims 34-39 and 41-42 under 35 USC §103(a) as being unpatentable over Cousins in view of Kasper. Applicant respectfully submits that claims 34-39 and 41-42 are patentable over Cousins in view of Kasper.

As to claims 34, 38, and 41, as discussed above for claim 1 (from which all of these claims depend), Cousins does not disclose a motor mounting platform “wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least one motor support” as recited in claim 1, as amended. In addition, Kasper does not disclose a motor mounting platform “wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least one motor support.” Therefore, even if such a combination as Cousins and Kasper were made, the purported combination still would not disclose all of the elements recited in claims 34, 38, and 41.

In addition, as to claim 34, as argued in Applicant’s August 25, 2004 Response to Office Action (this argument was not responded to in the December 2, 2004 Office Action), as noted by the Examiner, Cousins does not disclose a motor mounting platform having “a first side and a second side in which the second side includes a cavity surrounded by a wall” as recited in claim 34. In addition, Kasper also does not disclose a motor mounting platform having “a first side and a second side in which the second side includes a cavity surrounded by a wall.” The reference identified by the Examiner in Kasper (22 in Fig. 1) is not a motor mounting platform but is actually a cap that covers the entire top portion of the vacuum. The motor mounting platform in Kasper is actually reference 52 and it does not have a second side that includes a cavity

surrounded by a wall. Therefore, even if such a combination as Cousins and Kasper were made, the purported combination still would not disclose all of the elements recited in claim 34.

As to claim 38, as argued in Applicant's August 25, 2004 Response to Office Action (this argument was not responded to in the December 2, 2004 Office Action), neither Cousins nor Kasper disclose a motor mounting platform "wherein an exhaust outlet extends from the mounting platform" as recited in claim 38. The reference identified by the Examiner in Kasper (chamber 74 in Fig. 1) does not extend from the mounting platform 52 but rather is part of and extends from the blower assembly 18. Therefore, even if such a combination as Cousins and Kasper were made, the purported combination still would not disclose all of the elements recited in claim 38.

Claims 35-37 are dependent on claim 34, claim 39 is dependent on claim 38, and claim 42 is dependent on claim 41, therefore, for the reasons stated above are also patentable over Cousins in view of Kasper.

The Examiner also rejected claim 45 under 35 USC §103(a) as being unpatentable over Cousins in view of Morimoto ('323). Applicant respectfully submits that claim 45 is patentable over Cousins in view of Morimoto ('323).

Claim 45 is dependent on claim 44, which in turn is dependent on claim 1. As discussed above, Cousins does not disclose a motor mounting platform "wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least one motor support" as recited in claim 1, as amended. In addition, Morimoto ('323) also does not specifically disclose a motor mounting platform "wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least

one motor support.” In addition, as argued in Applicant’s August 25, 2004 Response to Office Action (this argument was not responded to in the December 2, 2004 Office Action), neither Cousins nor Morimoto (‘323) disclose brush holder guides that are “adapted to permit the brush holders to be removed from the motor mounting platform” as recited in claim 44. Therefore, even if such a combination of Cousins and Morimoto (‘323) were made, the purported combination still would not disclose all of the elements recited in claim 45.

Assuming for arguments sake that the brush holders in Morimoto (‘323) were removable from the motor mounting platform, Applicant submits that it would not have been obvious to a person skilled in the art to modify Cousins with the brush holder guides in Morimoto (‘323). The Examiner fails to point out and Applicant fails to find any suggestion or motivation in either Cousins or Morimoto (‘323) to combine the references. There is no mention in Cousins of the brush holder being removable. Similarly, assuming for arguments sake that the brush holders in Morimoto (‘323) were removable, there is no mention in Moritomo (‘323) of the brush holders being non-removable and no mention of using the brush holder guides disclosed in place of other guides that make the brush holders non-removable. The only potential teaching for combining these references is Applicant’s own patent application. Using Applicant’s own invention to supply the motivation for combining references is inappropriate. As stated in MPEP §2143.01, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” In re Mills, 916 F.2d 680, 16 USPQ 1430 (Fed. Cir. 1990). As that section further states, “Although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” In re Mills, 916 F.2d at 682. See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

If the Examiner maintains the rejection of claim 45, Applicant requests that the Examiner point out with specificity the motivation disclosed in the cited references that supports the asserted combination.

The Examiner also rejected claim 46 under 35 USC §103(a) as being unpatentable over Cousins in view of Morimoto ('145). Applicant respectfully submits that claim 46 is patentable over Cousins in view of Morimoto ('145).

Claim 46 is dependent on claim 44, which in turn is dependent on claim 1. As discussed above, Cousins does not disclose a motor mounting platform "wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least one motor support" as recited in claim 1, as amended. In addition, Morimoto ('145) also does not disclose a motor mounting platform "wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least one motor support." In addition, as argued in Applicant's August 25, 2004 Response to Office Action (this argument was not responded to in the December 2, 2004 Office Action), neither Cousins nor Morimoto ('145) disclose brush holder guides that are "adapted to permit the brush holders to be removed from the motor mounting platform" as recited in claim 44. Therefore, even if such a combination of Cousins and Morimoto ('145) were made, the purported combination still would not disclose all of the elements recited in claim 46.

Assuming for arguments sake that the brush holders in Morimoto ('145) were removable from the motor mounting platform, Applicant submits that it would not have been obvious to a person skilled in the art to modify Cousins with the brush holder guides in Morimoto ('145). The Examiner fails to point out and Applicant fails to find any suggestion or motivation in either

Cousins or Morimoto ('145) to combine the references. There is no mention in Cousins of the brush holder being removable. Similarly, assuming for arguments sake that the brush holders in Morimoto ('145) were removable, there is no mention in Moritomo ('145) of the brush holders being non-removable and no mention of using the brush holder guides disclosed in place of other guides that make the brush holders non-removable. The only potential teaching for combining these references is Applicant's own patent application. Using Applicant's own invention to supply the motivation for combining references is inappropriate. As stated in MPEP §2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ 1430 (Fed. Cir. 1990). As that section further states, "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" In re Mills, 916 F.2d at 682. See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

If the Examiner maintains the rejection of claim 46, Applicant requests that the Examiner point out with specificity the motivation disclosed in the cited references that supports the asserted combination.

In addition, as argued in Applicant's August 25, 2004 Response to Office Action (this argument was not responded to in the December 2, 2004 Office Action), as noted by the Examiner, Cousins does not disclose "a stop bar [that] is mounted to the motor mounting platform between each pair of brush holder guides" as recited in claim 46. In addition, Morimoto ('145) also does not disclose "a stop bar [that] is mounted to the motor mounting platform between each pair of brush holder guides." First, Morimoto ('145) does not disclose a stop bar mounted to a motor mounting platform. The tabs 21 in Morimoto ('145) are not mounted to a

motor mounting platform but are formed in a steel plate 4. Second, the tabs in Morimoto ('145) are not mounted between a pair of brush holder guides. Morimoto does not disclose brush holder guides at all. Therefore, even if such a combination of Cousins and Morimoto ('145) were made, the purported combination still would not disclose all of the elements recited in claim 46.

Furthermore, as argued in Applicant's August 25, 2004 Response to Office Action (this argument was not responded to in the December 2, 2004 Office Action), the tabs 21 disclosed in Morimoto ('145) could not be used on the motor mounting platform 38 disclosed in Cousins. The tabs 21 disclosed in Morimoto ('145) are formed in the steel plate, are inserted through holes in the brush holder, and then are bent to hold the brush holder in place. The motor mounting platform 38 disclosed in Cousins is made from a non-conducting plastic material such as PolyButylene Tetraphalate. Therefore, even if the tabs in Morimoto ('145) were formed in the motor mounting plate 38 of Cousins, they could not be bent over to secure the brush holder and could not serve the function for which they were intended.

The Examiner also rejected claims 47, 48, 54, and 55 under 35 USC §103(a) as being unpatentable over Cousins in view of Yamaguchi. Applicant respectfully submits that claims 47, 48, 54, and 55 are patentable over Cousins in view of Yamaguchi.

Claims 47 and 54 are both dependent on claim 44, which in turn is dependent on claim 1. Cousins does not disclose a motor mounting platform "wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least one motor support" as recited in claim 1, as amended. In addition, Yamaguchi also does not disclose a motor mounting platform "wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least one motor support." In addition,

as argued in Applicant's August 25, 2004 Response to Office Action (this argument was not responded to in the December 2, 2004 Office Action), neither Cousins nor Yamaguchi disclose brush holder guides that are "adapted to permit the brush holders to be removed from the motor mounting platform" as recited in claim 44. Therefore, even if such a combination of Cousins and Yamaguchi were made, the purported combination still would not disclose all of the elements recited in claims 47 and 54.

Claim 48 is dependent on claim 47 and claim 55 is dependent on claim 54, therefore, for the reasons stated above these claims are also patentable over Cousins in view of Yamaguchi.

In addition, as argued in Applicant's August 25, 2004 Response to Office Action (this argument was not responded to in the December 2, 2004 Office Action), Applicant submits that it would not have been obvious to a person skilled in the art to modify Cousins with the brush holders in Yamaguchi. The Examiner fails to point out and Applicant fails to find any suggestion or motivation in either Cousins or Yamaguchi to combine the references. There is no mention in Cousins of having brush holders that allow a "pigtail" to protrude from the side of the brush holder and no mention of a desire to be able to do so. Similarly, there is no mention in Yamaguchi of using the brush holders with openings in the side to allow the protrusion of "pigtails" in place of brush holders that do not have such an opening. The only potential teaching for combining these references is Applicant's own patent application. Using Applicant's own invention to supply the motivation for combining references is inappropriate. As stated in MPEP §2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ 1430 (Fed. Cir. 1990). As that section further states, "Although a prior art device 'may be capable of being modified to run the way the

apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” In re Mills, 916 F.2d at 682. See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

If the Examiner maintains the rejection of claims 47, 48, 54, and 55, Applicant requests that the Examiner point out with specificity the motivation disclosed in the cited references that supports the asserted combination.

In addition, as to claims 54 and 55 (which is dependent on 54), as argued in Applicant’s August 25, 2004 Response to Office Action (this argument was not responded to in the December 2, 2004 Office Action), neither Cousins nor Yamaguchi disclose a motor mounting platform “wherein the at least one motor support [is]...integrally molded with the motor mounting platform” as recited in claim 54. Yamaguchi does not disclose a motor mounting platform or a motor support at all. In addition, Cousins does not disclose a motor support that is integrally molded with the motor mounting platform. The element identified by the Examiner in Cousins (“the rim that surrounds center hole in Fig. 3”) as the integral motor support is not a motor support. The rim that surrounds the center hole in Fig. 3 supports the armature assembly 30 and not the motor 12. Furthermore, the Examiner stated in the Office Action that the casing 14 in Cousins supported the motor and was the motor support and the casing 14 in Cousins is not integrally molded with the motor mounting platform 38.

The Examiner also rejected claims 49-51 under 35 USC §103(a) as being unpatentable over Cousins in view of Yamaguchi and further in view of Morimoto (‘323). Applicant respectfully submits that claims 49-51 are patentable over Cousins in view of Yamaguchi and further in view of Morimoto (‘323).

Claims 49-51 are all dependant on claim 47. Therefore, for the reasons stated above for claim 47, the combination of Cousins and Yamaguchi does not disclose all of the elements

recited in claims 49-51. In addition, Morimoto ('323) does not disclose a motor mounting platform "wherein the motor mounting platform is not in contact with any current carrying component by an electrically conductive component when the motor is attached to the at least one motor support" or brush holder guides that are "adapted to permit the brush holders to be removed from the motor mounting platform" or a brush holder having "a top side including a first slot in communication with the opening and a second slot in communication with the opening, positioned perpendicular to the first slot, and positioned proximate the second end." Therefore, even if such a combination of Cousins, Yamaguchi, and Morimoto ('323) were made, the purported combination still would not disclose all of the elements recited in claims 49-51.

In addition, as to claim 51, neither Cousins nor Yamaguchi nor Morimoto ('323) disclose a brush holder "wherein the bottom side includes a notch capable of engaging a stop bar" as recited in claim 51. Cousins and Yamaguchi make no mention of any type of notch in the bottom side of the brush holder. In addition, Applicant cannot find the notch identified by the Examiner (ref. 20 in Fig. 7) in Morimoto ('323). Assuming that the Examiner meant the notch 20 in Figure 7 of Morimoto ('145), this notch 20 is in the steel plate 4 and not in the brush holder.

Conclusion

In view of the aforesaid, Applicant respectfully submits that claims 1-3, 34-39, 41, 42, and 44-56 are in condition for allowance and favorable reconsideration and a Notice of Allowance for these claims is respectfully requested.

Dated: _____

Feb. 2, 2005

Respectfully submitted,

By: _____

Thomas J. Ring
Reg. No. 29,971
Attorney for Applicant
Wildman, Harrold, Allen & Dixon LLP
225 West Wacker Drive
Suite 3000
Chicago, IL 60606
P: 312-201-2000
F: 312-201-2555

CERTIFICATE OF EXPRESS MAIL

"Express Mail" mailing label number: EV265502934US
Date of Deposit: 2/2/05

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Valeria C. Rodriguez